



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**NOTICE OF APPEAL FROM THE EXAMINER
TO THE BOARD OF APPEALS**

Applicant(s): Wilcock et al.
Serial No.: 09/788,422
Filed: 21 February 2001
For: Augmentation of Sets of Image Recordings
Examiner: Brian Q. Le
Art Unit: 2624
Confirmation No.: 5849
Customer No.: 27673 Attorney Docket: 30003000-02US

Mail Stop Appeal Brief-Patents
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

We are enclosing for filing in the above-identified application the following:

1. Substitute Appeal Brief (*in triplicate*);
2. Transmittal letter in duplicate; and
3. Postcard.

Please charge any additional fees or credit any such fees, if necessary to Deposit Account No. **08-2025**. A duplicate copy of this sheet is attached.

Respectfully submitted,

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December 20, 2006

Date

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: MAIL STOP Appeal Brief-Patents, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, ON December 20, 2006.

Marilyn Alexander

(Typed name of person mailing paper)

(Signature of person mailing paper)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Wilcock et al.
Serial No.: 09/788,422
For: Augmentation of Sets of Image Recordings
Filed: 21 FEB 2001
Examiner: Brian Q. Le
Art Unit: 2624
Confirmation No.: 5849
Customer No.: 27,623 Attorney Docket No.: 30003000-02US

SUBSTITUTE APPEAL BRIEF FILED UNDER 35 U.S.C. §134

Mail Stop Appeal Brief - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On 25 OCT 2006, Appellants submitted an Appeal Brief for the above-noted application.

On 20 NOV 2006, the Office mailed a Notification of Non-Compliant Appeal Brief that identified a deficiency in the Appeal Brief.

Appellants are submitting the present Substitute Appeal Brief to address the deficiency that was identified in the Notification of 20 NOV 2006.

Appellants are filing this Substitute Appeal Brief under 35 U.S.C. §134 and in accordance with the provisions of 37 C.F.R. §41.37(a), and believe that the Appeal Brief complies with the requirements set forth in 37 C.F.R. §41.37(c). The claims on appeal are set forth in an Appendix, below.

The undersigned attorney does not believe that a petition or fee for an extension of time is required to file this Substitute Appeal Brief. However, should the undersigned attorney be mistaken, please consider this to be a petition for any required extension of time, and please then also charge **Deposit Account No. 08-2025** for the required fee. Likewise, the Commissioner is hereby authorized to charge Deposit Account No. 08-2025 for any required fee not submitted herewith, or submitted incorrectly, so as to maintain the pendency of the above-identified patent application.

(1) Real Party in Interest

The real party in interest is Hewlett-Packard Company.

(2) Related Appeals and Interferences

The undersigned attorney is not aware of any related appeals or interferences.

(3) Status of the Claims

Claims 1 - 11 are rejected. Claim 12 is canceled. Thus, claims 1 - 11 are pending in this application, and are the subject of this Appeal. The claims can be found below in an Appendix.

(4) Status of Amendments

On 3 MAY 2006, the Office mailed a final office action (hereinafter "the Office Action") rejecting claims 1 - 11. No amendments to any of the claims were proposed subsequent to the Office Action.

(5) Summary of Claimed Subject Matter

This Summary makes reference to FIG. 17, which is provided below, at the end of the Summary.

Recording a location independently of taking a photo has relevance to photo creation. For example, the situation may arise that a user would like to take a photograph of a place or item but has run out of film / on-camera storage, or is present at a time when it is not possible to take a photograph (at night, in heavy rain or mist, etc). In such cases, the user can record their location in a photo location log and subsequently retrieve from the Web (or other photo archive) a photograph similar to that the user wanted to take. (page 18, lines 26 – 31)

FIG. 17 is a diagram showing the recording of the location of desired but not taken photos and the subsequent retrieval of matching images (page 4, lines 11 – 12). In FIG. 17, there is shown a camera 90 provided with location discovery means 29 for location stamping photos. A control means 93 of the camera, when activated by user operation of an input control 28, can be arranged to enable location information 98 to be stored in a memory 94 without the need to actually record image data 95. This permits the camera to log the location of a desired but untaken photo. (page 19, lines 1 – 5)

An album program 50 loads location data from camera 90 (page 19, lines 14 – 16). Thereafter, program 50 executes a process in which a user is given the option of fetching (or initiating an automatic fetch of) photo image data from the Internet to match the location concerned. This process is depicted in FIG. 17 where desired image data is supplied (arrow 172) by a specialised service 174 set up to provide such image data in response to requests (arrow 171). (page 20 , lines 1 – 4)

The application contains two independent claims, namely claims 1 and 11. Below, Appellants are providing a concise explanation of the subject matter of claims 1 and 11, with reference to the specification by page and line number, and to the drawings by reference characters.

Concise Explanation of the Subject Matter of Claim 1:

Please refer to FIG. 17.

1. A method comprising:

recording, in association with taking a first image recording (photo data 95) with a camera (camera 90), first data (location 98) indicative of a geographic location of said camera (page 2, line 28 - page 3, line 2);

recording, in response to an activation of said camera, and separately from taking an image recording using said camera, second data (location data 98 in item 175) indicative of a geographic location of said camera (page 19, lines 1 - 11); and

retrieving (arrow 172), from a resource (service system 40) separate from said camera, a second image recording concerning said geographic location indicated by said second data, wherein said second image recording was taken by a device other than said camera (page 20, lines 2 - 4).

Concise Explanation of the Subject Matter of Claim 11:

Please refer to FIG. 17.

11. A method, comprising:

recording a first image (photo data 95) using a camera (camera 90) (page 2, line 28 - page 3, line 2);

recording, in response to an activation of said camera, but separately from taking an image recording using said camera, data (location data 98 in item 175) indicative of a geographic location of said camera, said data being so recorded as to indicate an association with said first image (page 13, lines 12 - 20; page 15, line 14 - page 16, line 5 (e.g., timestamp); and page 19, lines 1 - 11); and

retrieving (arrow 172), based on said data, from a resource (service system 40) other than said camera, a second image concerning said geographic location, wherein said second image recording was taken by a device other than said camera (page 20, lines 2 - 4; and page 20, line 23 - page 21, line 7).

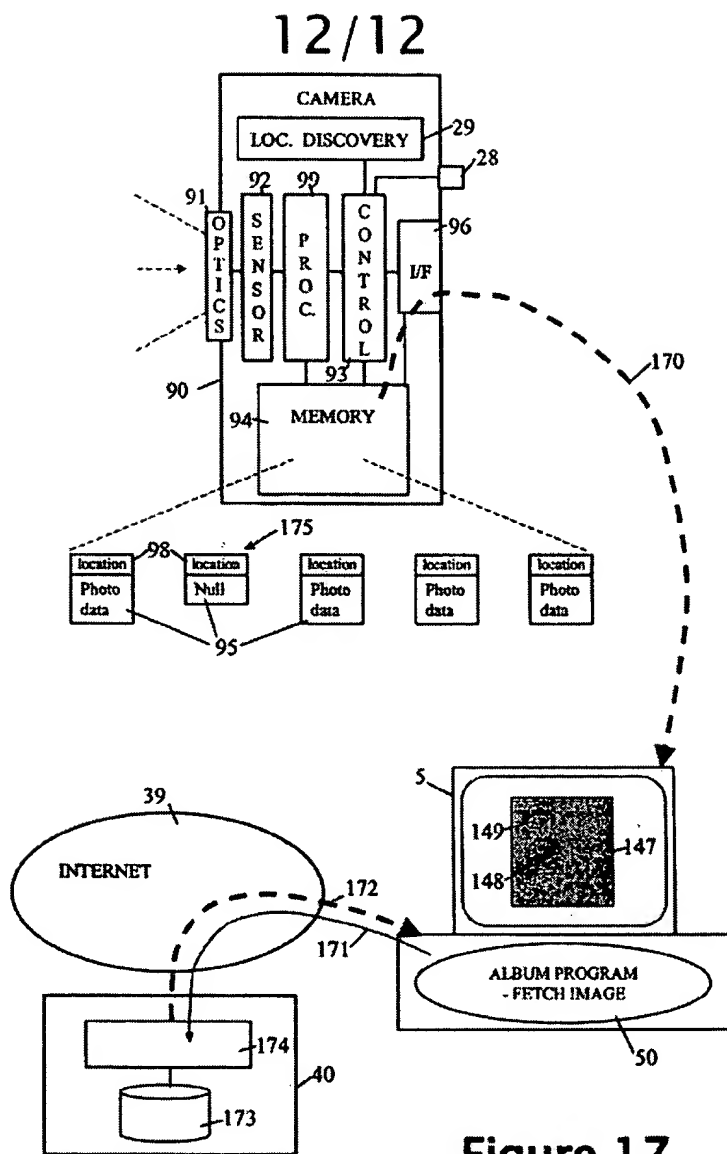


Figure 17

(6) Grounds of Rejection to be Reviewed on Appeal

The issues presented for review are the propriety of the Examiner's final rejection of:

- (a) claims 1 – 5, 7, 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over a combination of U.S. Patent No. 5,606,627 to Kuo (hereinafter "the Kuo patent") and U.S. Patent No. 6,133,945 to Stuetzler (hereinafter "the Stuetzler patent");
- (b) claim 6 under 35 U.S.C. §103(a) as being unpatentable over a combination of the Kuo and Stuetzler patents, and further in view of U.S. Patent No. 5,806,072 to Kuba et al. (hereinafter "the Kuba et al. patent"); and
- (c) claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over a combination of the Kuo and Stuetzler patents, and further in view of U.S. Patent No. 6,272,235 to Bacus et al. (hereinafter "the Bacus et al. patent").

(7) Argument

(a) Claims 1 – 5, 7, 8 and 11 stand or fall together.

Argument with respect to the rejection of claims 1 – 5, 7, 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over a combination of the Kuo and Stuetzler patents.

Claim 1 provides for a method that includes, *inter alia*, (a) recording, in association with taking a first image recording with a camera, first data indicative of a geographic location of the camera, (b) recording, in response to an activation of the camera, and separately from taking an image recording using the camera, second data indicative of a geographic location of the camera, and (c) retrieving, from a resource separate from the camera, a second image recording concerning the geographic location indicated by the second data, wherein the second image recording was taken by a device other than the camera. That is, the method involves recording data indicative of a geographic location of a

camera, and retrieving an image recording concerning the geographic location (of the camera) indicated by the data.

The Kuo patent is directed toward a technique for extracting digital elevation data from a pair of stereo images with two corresponding sets of airborne control data associated with each image of the stereo image pair (Abstract). The pair of images includes (a) a left image taken from a first camera station O_L , and space coordinates of the first camera station O_L , and (b) a right image taken from a second camera station O_R , and space coordinates of the second camera station O_R (see FIG. 1B, items 22 and 24; FIG. 2, items O_L and O_R , and col. 7, lines 20 – 48).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Kuo patent expressly states that images taken from the first camera station O_L are associated with space coordinates of the first camera station O_L , and images taken from the second camera station O_R are associated with space coordinates of the second camera station O_R . The Kuo patent does not describe or suggest retrieving an image from the second camera station O_R concerning the space coordinates of the first camera station O_L . Moreover, retrieving an image from the second camera station O_R concerning the space coordinates of the first camera station O_L , would obviate the use of the space coordinates of the second camera station O_R , thus **changing the principle of operation of the Kuo patent**. As such, the teaching of the Kuo patent is not sufficient to render obvious retrieving, from a resource separate from the camera, a second image recording concerning the geographic location indicated by the second data (which indicates a geographic location of the camera), wherein the second image recording was taken by a device other than the camera, as recited in claim 1.

This deficiency on the part of the Kuo patent, as the Kuo patent relates to claim 1, **cannot be cured by combining the Kuo patent with another reference.** Nevertheless, the Office Action is rejecting claim 1 based on a combination of the Kuo and Steuttler patents.

The Steuttler patent concerns a method and device for displaying images when viewing an object through a video stereomicroscope (col. 1, lines 6 – 9). However, as mentioned above, the Kuo patent is specifically directed toward a processing of airborne data. Appellants respectfully submit that the relative locations of cameras in a stereomicroscope (most likely in very close proximity to one another) are not suggestive of the relative locations of airborne cameras (most likely significantly separated from one another). Accordingly, a modification of the airborne system in the Kuo patent to include cameras as situated in the stereomicroscope of the Steuttler would render the airborne system in the Kuo patent unsuitable for its intended purpose. Thus, **the cited combination of the Kuo and Steuttler patents is not sufficient** to render claim 1 *prima facie* obvious.

Claims 2 – 5, 7 and 8 depend from claim 1. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Whereas claim 1 is patentable over the cited combination of the Kuo and Steuttler patents, so are claims 2 – 5, 7 and 8.

Claim 11 is an independent claim, and includes recitals similar to those of claim 1, as described above. Therefore, claim 11, for reasoning similar to that provided above in support of claim 1, is also patentable over the cited combination of the Kuo and Steuttler patents.

Appellants respectfully request that the Board of Appeals reverse the final rejection of claims 1 – 5, 7, 8 and 11.

(b) Claim 6 stands alone.

Argument with respect to the rejection of claim 6 under 35 U.S.C. §103(a) as being unpatentable over a combination of the Kuo and Steuttler patents, and further in view of the Kuba et al. patent.

Claim 6 depends from claim 1. As mentioned above, the deficiency on the part of the Kuo patent, as the Kuo patent relates to claim 1, cannot be cured by combining the Kuo patent with another reference. Thus, claim 1, and claim 6 by virtue of its dependence on claim 1, are both patentable over the cited combinations of the Kuo, Stuetzler and Kuba et al. patents. Appellants respectfully request that the Board of Appeals reverse the final rejection of claim 6.

(c) Claims 9 and 10 stand together.

Argument with respect to the rejection of claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over a combination of the Kuo and Steuttler patents, and further in view of the Bacus et al. patent.

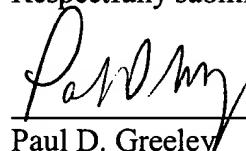
Claims 9 and 10 depend from claim 1. As mentioned above, the deficiency on the part of the Kuo patent, as the Kuo patent relates to claim 1, cannot be cured by combining the Kuo patent with another reference. Thus, claim 1, and claims 9 and 10 by virtue of their dependence on claim 1, are all patentable over the cited combinations of the Kuo, Stuetzler and Bacus et al. patents. Appellants respectfully request that the Board of Appeals reverse the final rejection of claims 9 and 10.

In view of the foregoing arguments, Appellant respectfully requests that the Board of Appeals reverse the final rejections of the claims, thereby enabling all of the pending claims to be allowed.

Respectfully submitted,

Date

12/20/06



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(8) Claims Appendix

The claims on appeal are set forth below.

1. (previously presented) A method comprising:
recording, in association with taking a first image recording with a camera, first data indicative of
a geographic location of said camera;
recording, in response to an activation of said camera, and separately from taking an image
recording using said camera, second data indicative of a geographic location of said
camera; and
retrieving, from a resource separate from said camera, a second image recording concerning said
geographic location indicated by said second data, wherein said second image recording
was taken by a device other than said camera.
2. (previously presented) A method according to claim 1, wherein both said first data and said
second data are recorded in a recording arrangement that is separate from said camera.
3. (previously presented) A method according to claim 2, wherein said first data and said second
data are recorded in a same sequence of data items.
4. (previously presented) A method according to claim 1, wherein said first data and said second
data are recorded in said camera.
5. (previously presented) A method according to claim 4, wherein said first data and said second
data are recorded in a same sequence of data items.
6. (previously presented) A method according to claim 1, wherein said retrieving comprises
retrieving multiple image recordings, displaying said multiple image recordings, and enabling a user to
choose at least one of said multiple image recordings for retention and association with said first image
recording.

7. (previously presented) A method according to claim 1, wherein said retrieving comprises displaying a map of an area around said geographic location indicated by the second data and obtaining an input detailing a target subject, zone or point, and using said input to facilitate said retrieving.

8. (previously presented) A method according to claim 1,
wherein subsequent to taking said first image recording, a map display shows locations where
said first image recording was taken,
wherein prior to said retrieving, an item is represented on said map display, and
wherein said item corresponds to said geographic location indicated by said second data.

9. (previously presented) A method according to claim 8, wherein when said map display is present, retrieval of an image recording corresponding to said item is initiated by clicking on a displayed graphic element associated with a displayed location corresponding to said item.

10. (previously presented) A method according to claim 1, wherein said retrieving comprises contacting an Internet service system operative to provide image recordings to registered users on the basis of location data supplied in a service request.

11. (previously presented) A method, comprising:
recording a first image using a camera;
recording, in response to an activation of said camera, but separately from taking an image recording using said camera, data indicative of a geographic location of said camera, said data being so recorded as to indicate an association with said first image; and
retrieving, based on said data, from a resource other than said camera, a second image concerning said geographic location, wherein said second image recording was taken by a device other than said camera.

12. (canceled)

(9) Evidence Appendix

None.

(10) Related Proceedings Appendix

None.